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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,071	01/18/2002	Fernando Marin Paricio	MARIN PARICIO	5580

25782 7590 02/21/2006

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EXAMINER

MCPHERSON, JOHN A

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/053,071	Applicant(s) PARICIO, FERNANDO MARIN	
	Examiner John A. McPherson	Art Unit 1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1, lines 15-16 presents the limitation "developing said emulsion *by attacking the metal with salts or acids* on the areas unprotected by the emulsion", however this does not correspond to the invention as described in the specification.

In the specification, it does not appear that the emulsion is developed by attacking the metal with salts or acids. Instead, it is taught that the photosensitive emulsion is developed, and then salts or acids are used to attack the surface of the metal not protected by the printed parts of the emulsion (i.e. the salts or acids do not develop the emulsion, as is currently claimed, but are instead utilized to attack the parts of the metal which are not protected by the developed emulsion pattern). For example, see page 3, lines 8-22 and page 6, line 20 to page 7, line 4 of the specification.

This rejection could be overcome by replacing lines 15-16 of claim 1 with a step of --developing said emulsion;--, and a further step of --attacking the metal with salts or acids on the areas unprotected by emulsion;--.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2004/0007558 to Sim (Sim) in view of US 5,920,977 to Wyckoff et al. (Wyckoff). Sim discloses a manufacturing method for a high-density copper plate memorial comprising the steps of digitizing a desired image; converting the image into a halftone image, printing the halftone image into a transparent film (corresponding to the photographic positive or negative of the present invention); coating the surface of a foreign-materials free copper plate with a glue containing a hardening agent and a photosensitizer (corresponding to the photosensitive emulsion of the present invention); compressing the printed image film to the copper plate for its photosensitization (corresponding to the making contact step and the exposing step of the present invention); heating the glue for appropriate etching; and coating the copper plate with a protective film. See paragraphs [0020]-[0024], [0050] and [0051]. However, Sim does not disclose an embodiment wherein the protective film is a transparent enamel. Furthermore, Sim does not disclose the temperature range at which the photosensitized glue is heated for appropriate etching.

Wyckoff discloses a process of making a sign comprising the steps of encapsulating an alloy substrate with a photo-resist; imagewise exposing the

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photoresist; removing portions of the photoresist not exposed to light; etching the substrate; and encapsulating the alloy substrate in a protective coating of porcelain enamel. See column 9, lines 1-13.


It would have been obvious to one skilled in the requisite art to utilize porcelain enamel, as taught by Wyckoff, as the protective film in the process of Sim because it is taught that porcelain enamel provides a protective layer which is resistant to wear, alteration and/or destruction when provided on a metallic substrate having an image etched into its surface. Furthermore, It would have been obvious to one skilled in the requisite art to heat the photosensitized glue of Sim to a temperature of 200-400 C for appropriate etching characteristics, since it has been held that discovering the optimum or workable value or range of a result effective variable involves only routine skill in the art. *In re Aller*, 105 USPQ 233 and *In re Boesch*, 617 F.2d 272,205 USPQ 215 (CCPA 1980).

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. McPherson whose telephone number is (571) 272-1386. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on (571) 272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John A. McPherson
Primary Examiner
Art Unit 1756

JAM
2/15/06